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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,971	09/05/2002	Sheng-Chih Lin	CHEP0009USA	7018

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EXAMINER

ROHWER, JACOB P

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/064,971	<b>Applicant(s)</b> LIN ET AL.	
	<b>Examiner</b> Jacob P. Rohwer	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5 Sept 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

The informal drawings are not of sufficient quality to permit examination. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit replacement drawing sheets will result in ABANDONMENT of the application.

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Fig 6 is unreadable. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3, 7-9 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No 5,775,918 to Yanagida et al, in view of US Patent No 5,085,587 to DesForges et al.

Regarding claim 1, Yanagida discloses a method for correcting a document by a printer, the printer comprising a sensor, the printer capable of receiving the document and printing data onto a copy of the document, the method comprising:

receiving the document; **(Col 15 Lin 5-7)**

determining if the document has a printing sign using the sensor; **(Fig 12 #36, Col 15 Lin 34-41, The correct answer is the printing sign in the Yanagida invention.)**

printing data onto a copy of the document with the printer when the document does not have the printing sign; **(Fig 19 #85, Col 16 Lin 34-39, The printer writes the total score on the examination paper) and**

printing the printing sign onto the copy of the document with the printer when the document does not have the printing sign. **(Col 16 Lin 25-39, when the examination does not have the correct answer, characters or symbols representing the correct answer can be drawn on the copy of the examination.)**

Yanagida does not expressly disclose, that the marking and correcting is done on the same copy or document that has been scanned in, i.e. the original test paper.

However, DesForges discloses a test examination correction method where the correct answers are drawn on the original test when an incorrect answer has been determined. **(Col 7 Lin 8-19)**

The Yanagida and the DesForges Patents are combinable because they both come from the same field of endeavor relating to correcting test examinations.

At the time of the invention, it would have been obvious to one of ordinary skill in the art that in the absence of the printing signs (correct answers) on an examination, to print the correct printing sign as specified in Yanagida on the original test examination document as specified in DesForges.

The suggestion/motivation for doing so would have been to save paper by not producing copies and allowing the examinee to see corrections made to the original test document.

Therefore, it would have been obvious to combine the Yanagida and DesForges Patents in order to obtain the invention as specified in claim 1.

Regarding claim 2, Yanagida further discloses the method of claim 1 wherein the printer prints data onto the document inside a print area of the document; and the printer prints the printing sign onto the document outside the print area of the document. **(Fig 19 discloses the print data the total correct score in the box #85, and the corrections made to incorrect answers inside the answer box #84. As mentioned in the rejection of claim 1, corrections representing the correct answers could be made, which means the printing sign being searched for by the sensor (the**

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**correct answer) could be printed in the answer box #84, outside the print area of the print data representing the total score, box #85.)**

Regarding claim 3, Yanagida further discloses the method of claim 1 wherein the printing sign is a sign inside a print area of the document. **(Fig 19, the correct marks are marked on a print area of the document, inside the answer boxes #84)**

Regarding claim 7, Yanagida further discloses the method of claim 1 wherein the printer prints one color at a time. **(Col 16 Lin 41-51, two colors if image data are printed out separately)**

Regarding claim 8, Yanagida further discloses the method of claim 1 wherein the printer further comprises a capstan roller and a pinch roller capable of driving the document forward and backward. **(Fig 9 discloses the laser printer with many rollers provided to move the document back and forth through the printer.)**

Regarding claim 9, Yanagida further discloses the method of claim 8 wherein the printer further comprises a motor that drives the capstan roller to rotate. **(Col 11 Lin 36-38 discloses a drive to move the registration rollers.)**

Regarding claim 14, Yanagida further discloses the method according to claim 1, wherein the printer is an electrostatic printer. **(Fig 9, Col 10 Lin 47)**

**Claims 4-6 and 10-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yanagida and DesForges as specified in claim 1 above, in view of commonly known prior art at the time of the invention.

Regarding claims 4-6 and 10, the claims are directed toward a thermal transfer printer (claims 6 and 10) and its components, an ink ribbon and print head (claim 4),

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and a platen roller (claim 5). Official notice is taken, that at the time of the invention, it would have been obvious to use a thermal transfer printer and its components in the printer disclosed in the combination of Yanagida and DesForges as specified in claim 1.

The suggestion/motivation for doing so would have been to provide a less inexpensive printing mechanism compared to other printing techniques.

Regarding claims 11-13, the claims are directed toward the printer of claim 1 being a thermal inkjet printer (claim 11), a dot matrix printer (claim 12), and an inkjet printer (claim 13). Again, official notice is taken that at the time of the invention it would have been obvious for one of ordinary skill in the art to use any of these printing techniques in the printer as specified in the combination of Yanagida and DesForges.

The suggestion/motivation for doing so would have been to provide better drawing capability of the corrected marks, especially when the marks are small, by using an inkjet or dot matrix printer which allows for more precise printing.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob P. Rohwer whose telephone number is 571-272-5509. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on 571-272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*JR* 4/23/06

*Mark Zimmerman*

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